

## VI. REMARKS

In the Official Action, Claims 1-40 were rejected under double patenting, for reasons set forth in the Action. Claims 1, 4-9, 12-13, 15-21 and 23-40 were rejected under 35 U.S.C. 102 as anticipated by Wolff (US 5,327,486) for reasons set forth in the Action. Claim 14 was rejected under 35 U.S.C. 103 as being unpatentable over the combined teachings of Wolff in view of Villa-Real (US 4,481,382) for reasons set forth in the Action.

Reconsideration of these rejections is requested respectfully in view of the argument herein.

Claims 2-3, 10-11 and 22 were said to have allowable subject matter.

With respect to the rejection based on double patenting, it is noted that during the prosecution of these claims, the wording may be changed by amendment. Accordingly, it is requested that the requirement for submission of the terminal disclaimer be held in abeyance until the final wording of the claims is established.

Claim 1 has been amended to state that the portable terminal identifies the caller on the basis of an identification information and sends a reply, or directs the incoming call to another answering service. This amendment is believed to clarify the claim since the claim makes reference to a reply in a subsequent clause of the claim.

The primary reference is Wolff who teaches the two-way communication of telephone messages to generate a suitable

response to an identified caller when the intended respondent is unable to answer the telephone call. This reference was applied previously in the first two actions of the parent application. The arguments provided in the responses to those first two actions are believed to be valid also for the present claims. Accordingly, the arguments are repeated, as follows, in order to overcome the foregoing rejections, and to obtain allowance of all of the claims.

With respect to the teaching of Wolff, it is noted that he uses multiple communication devices including a telephone 20, 22 and a computer 18 distant from the telephone. Two communication channels are employed for nearly all of his communication functions. One of the channels is a typical telephone channel (local telephone exchange 10 and telephones 20, 22; col. 3 at lines 45-50), and the communication channel is a wireless channel for computer 18 (col. 3 at lines 42-43). An example of a function accomplished by only one channel is the transfer of a call to voice mail (Fig. 2) via blocks 24, 26, 28, and 29. The voice mail function is accomplished with the aid of the computer 18 without involvement of the telephone. The use of multiple channels facilitates the communication of different types of messages, and serves for directing all sorts of events to take place, including the determination of who is calling, what is a proper response, and a suitable way of making the response.

The situation addressed by the present invention deals with receiving a call, identifying the caller, selecting a suitable response, and communicating the response, all of this being accomplished by a single portable terminal connected to a central telephone exchange over a telephone channel such as a two wire system commonly used in a person's home or via wireless

as in the case of a cell phone. The present invention enables these functions to be performed without interrupting the caller when the caller is attending a meeting. How one can accomplish all of these functions, in accordance with the present invention, within the confines of a single portable terminal cannot be learned by use of multiple devices as taught by Wolff. In this respect, all that Wolff does is to suggest functions that would be nice to have, but his teaching is essentially useless for suggesting or anticipating how a person can accomplish the multiple functions via a single telephone device such as a cell phone.

In the present Office Action, the Examiner has made an interpretation according to which Wolff discloses a method wherein a single device, identified either as a lap-top computer or a portable terminal, identifies a caller and sends a response option or directs the incoming call to another voice mail answering machine. This interpretation is respectively traversed. The Wolff reference teaches the use of at least two separate devices, one of which is a "computer platform 14" (see, for example, column 3, lines 36-37) while the other is a "palmtop computer 18" (sec column 3, lines 39 - 40). The computer platform 14 is connected to the "public local exchange telephone network 10" (column 3, lines 34 - 35 and 49 - 50), meaning that it can by no means be a portable terminal, and it runs the software that implements the "personal telephone manager 12 (PTM)" (column 3, lines 35 - 36 and 50). The identification of the caller is accomplished exclusively by the PTM (column 3, lines 51 - 55), and certainly not by the palmtop computer (or portable terminal) 18. The Examiner refers to column 4, lines 20 - 27 and 33 - 38; however, these lines 20 - 27 only describe the reception of a data packet by the palmtop computer. This data

packet has been sent by the PTM program 12 running in the computer platform 14, and it contains the identification information produced by the PTM; see column 4, lines 11 - 12. Lines 33 - 38 tell how the palmtop computer 18 takes the information from the arrived packet and displays it to the user with a selection of call control alternatives.

It is noted that the palmtop computer does not need to identify the caller because the PTM has done that already. The palmtop computer only displays the received identification information to the user. Additionally it is not the call that is routed from the PTM to the palmtop computer. Only a data packet is transmittal carrying more or less the following information which may be characterized as follows: "hey, there is a call from Mr. XXX waiting at the PTM in your office, what should we do with it?". If the end user decides to take the call, he transmits back instructions to "route the call to call to a specified current location" (column 4, lines 57 - 58), whereby the PTM routes the call to "the phone 20 at the user's current location" (column 4, lines 58 - 59). So if the call itself has to be routed to the called party, even a third device is needed! This is clearly distinguishable from the present invention wherein all functions are provided by a portable terminal.

The Examiner lists numerous functions allegedly provided by the laptop computer of Wolff. In fact, it is the fixed computer platform 14 of Wolff that performs the basic functions of responding to an incoming telephone call, including the most basic function of establishing the two-way communication link, which in the case of the usual handset, is accomplished by lifting the handset off of its base. This observation finds support in Wolff who discloses (col. 3 at line 46 to col. 4 at

line 6) that all of the operations listed in blocks 24 through 31 of Fig. 2 are carried out by the PTM 12 of the platform 14. Only when the procedure reaches block 32 (Fig. 2), does the palmtop computer 18 participate via the radio network 16 (col. 4 at lines 7-10). In contrast, the present claims recite the limitation "portable terminal". It is the portable terminal in the present invention that performs the functions of establishing telephone communication, not a hard wired device as in Wolff (platform 14).

It is urged further that the portable computer 18 of Wolff via its radio network 16 constitutes no more than an extension of the keyboard of the fixed platform 14. This is apparent from the Wolff description in col. 4 at lines 7-53. Therefore, it is clear that the portable computer 18 of Wolff can not be regarded as the same thing as the portable terminal of the present claims, nor suggest the portable computer of the present claims. The present portable terminal is a true radiotelephone.

In attempting to understand the position of the Examiner, it appears that the Examiner must be combining the laptop computer and the fixed platform of Wolff to obtain a device capable of establishing telephonic communication. But such a device would be a device permanently wired to the telephone system, which device is much different from a radiotelephone, as is well known in the art. Accordingly, it is believed that the rejection of anticipation under 35 USC 102 is not warranted by the cited art. In view of the foregoing analysis, it is urged that the teachings of the cited art are so far distant from the teachings of the present invention so as not to support even a rejection of obviousness of the present claims. With respect to the limitations of the dependent claims, it is noted that these

limitations provide for further distinction between the present claims and the teachings of the cited art, and thereby strengthen the foregoing argument.

It is noted further that Fig. 2 of Wolff illustrates the operation of the PTM to run exclusively on a fixed computer platform and not on a portable terminal. Therefore the teachings of Fig. 2 and the related passages in the text cannot disclose the invention as claimed, particularly in view of the fact that the present independent claims require all operations to take place in a portable terminal. Also, there are no calls coming to the laptop of Wolff, only data packets (meaning a kind of e-mail), and the laptop does not identify any callers, because the data packets coming thereto already contain the caller identification produced by the PTM at the fixed computer platform. This strengthens the foregoing argument that the cited art does not teach the present invention as claimed, neither in terms of a showing of telephonic devices nor in terms of a disclosure of the functions provided by such devices. Combining the teachings of Villa-Real with the teachings of Wolff does not alter the foregoing argument so that claim 14 should be allowable as well as the other claims.

It is emphasized that the present claims require that both the step of identifying a caller and the step of sending a reply must be accomplished within the portable terminal itself. It is requested respectfully that the Examiner show where, in a reference publication, there is a portable terminal that accomplishes these steps.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
\_\_\_\_\_  
Geza C. Ziegler, Jr.  
Reg. No. 44,004

5/9/03  
\_\_\_\_\_  
Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No.: 2512

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231.

Date: 5/9/03

Signature: Ronald Belandia  
Person Making Deposit